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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,434	10/15/2003	Tetsuro Motoyama	242160US2CONT	7907

22850 7590 10/05/2005

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EXAMINER	
LAO, SUE X	

ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/684,434	MOTOYAMA ET AL.	
	Examiner	Art Unit	
	Sue Lao	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10/15/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *(total 3)*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-32 are presented for examination.

3. This application is co-pending with a number of applications listed in the IDSes filed 1/15/2004 and 5/19/2005. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-32 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,662,225. Although the conflicting claims are not identical, they are not patentably distinct from each other. The present claims 1, 9, 17 and 25 are met by U.S. Patent No. 6,662,225, claims 1, 9, 17 and 25. The present claims 2-8, 10-16, 18-24 and 26-32 are met by U.S. Patent No. 6,662,225, claims 2-8, respectively.

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of independent claims 1, 9 and 17 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claims 1, 9 and 17 do not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of the claims. The

systems of claims 1 and 9 appear to be systems comprised entirely of software. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998). MPEP 2106. State Street required transformation of data by a machine before it applied the "useful, concrete, and tangible test." However, State Street does not hold that a "useful, concrete and tangible result" alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention appears to be comprised of software alone without claiming associated computer hardware required for execution.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 2, 5, 6, 8/1, 8/2, 8/5, 8/6, 9, 10, 13, 14, 16/9, 16/10, 16/13, 16/14, 17, 18, 21, 22, 24/17, 24/18, 24/21, 24/22, 25, 26, 29, 30, 32/25, 32/26, 32/29, 32/30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wyngodny et al (U S Pat. 6,202,199) in view of Hertermeister et al (U S Pat. 6,345,306).

As to claim 9, Wyngodny teaches a system comprising:

interface means (OCX/Active-X controls to be traced) of a target application means (client), the interface means for providing a plurality of operations to be selected by a user [inherent to the operations of OCX/Active-X controls] (col. 28, lines 28-38);

monitoring means for monitoring (trace library) data of selecting of the plurality of operations of the interface means by the user, and for generating a log (trace log file) of the monitored data (col. 6, lines 3-11),

communicating means for communicating the log of the monitored data (remote mode, send trace log file by e-mail, col. 6, lines 49-54).

While Wyngony teaches communicating data to a remote site (remote mode, col.s 5-6), which typically requires marshalling/packaging the data, Wyngodny does not teach packaging the log of the monitored data into different forms of the monitored data using a packaging object derived from an abstract class, and receiving an object derived from the abstract class including the log of the monitored data.

Hintermeister teaches data communication, including packaging the data (package elements) into different forms using a packaging object (packager 126) derived from an abstract class (Package base class of the framework), and receiving an object derived from the abstract class (derived classes such as Physical Contents) including the data (package elements, col. 6, lines 5-31).

Therefore, it would have been obvious to include packaging the log of the monitored data into different forms of the monitored data using a packaging object derived from an abstract class, and receiving an object derived from the abstract class including the log of the monitored data. One of ordinary skill in the art would have been motivated to combine the teachings of Wyngody and Hintermeister because this would have allowed easy and efficient definition of different output formats (col. 2, lines 5-37).

As to claim 1, note discussion of claim 9.

As to claim 17, 25, there are method claim and program product claim of claim 9 and thus note discussion of claim 9.

As to claims 2, 10, 18, 26, Wyngondy teaches the target application is a software application (client 102) and the interface is a display screen of the software application (OCX/Active-X controls to be traced) [It is noted that OCX/Active-X controls are used to implement typical GUI elements of window applications].

As to claims 5, 13, 21, 29, Wyngondy teaches sending the log of the monitored data when the user exits the target application (log and send trace log file when client terminates, col. 6, lines 1-20).

As to claims 6, 14, 22, 30, Wyngondy teaches a setting unit (trace control information CTI file) configured to set a number of sessions of the target application to be executed by the user prior to the communicating unit communicating the log of the monitored data (col. 10, line 51 – col. 11, line 30). Trace duration (number of sessions) is a typical trace control parameter, and therefore, it would have been obvious to include such information into the CTI file Wyngodny.

As to claims 8/1, 8/2, 8/5, 8/6, 16/9, 16/10, 16/13, 16/14, 24/17, 24/18, 24/21, 24/22, 32/25, 32/26, 32/29, 32/30, Wyngodny teaches the communicating unit communicates the log of the monitored data by Internet mail (send trace log file by e-mail, col. 6, lines 49-54).

10. Claims 3, 4, 11, 12, 19, 20, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyngodny et al in view of Hertermeister et al as applied to claims 1, 9, 17 and 25 and further in view of Motoyam (U S Pat. 5,568,618).

As to claims 3, 4, 11, 12, 19, 20, 27, 28, Motoyama teaches a target application is an image forming device and the interface is an operation panel of the image forming device, and a target application is an appliance and the

interface is an operation panel of the appliance (remote diagnostics on business office devices, col. 1, lines 16-33, col. 6, lines 8-38).

Therefore, it would have been obvious to include image forming device, appliance and operation panel into Wyngodny as modified. One of ordinary skill in the art would have been motivated to combine the teachings of Wyngody as modified and Motoyama because this would have provided controls of various models and products (col. 1, lines 53-62).

As to claims 10-16, note discussions of claims 2-8, respectively.

11. Claims 7, 8/7, 15, 16/15, 23, 24/23, 31, 32/31 would be allowable if rewritten to overcome the rejection(s) under the obviousness - type double patenting / under 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims, and subjected to a final search update.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (571) 272-3764. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (571) 272 3756. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 26, 2005

SUE LAO
PRIMARY EXAMINER